

Appl. No. : 10/063578
Filed : May 3, 2002

REMARKS

Claims 1-5 are pending for examination.

Obviousness

Claims 1-5 were rejected on the assertion that they are obvious over Strausberg (NCBI Accession No. BE531149 created August 7, 2000) in view of U.S. Patent No. 6,262,234. The Examiner asserts that Strausberg et al. teaches a nucleic acid sequence that encodes a polypeptide which is 100% identical to SEQ ID NO: 68. The Examiner further asserts that U.S. Patent No. 6,262,234 teaches methods for making antibodies.

The Examiner was unpersuaded by Applicants' previous arguments that the filing of Provisional Patent Application Serial No. 60/090246 on June 22, 1998 (prior to the August 7, 2000 publication date of Strausberg) is sufficient to overcome the Strausberg reference. According to the Examiner, the rejection under 103(a) is "based on a 102(a)-type date." *Office Action* at page 5. The Examiner cites MPEP 706.02(b) as stating:

"A rejection based on 35 U.S.C. 102(a) can be overcome by: (A) Persuasively arguing that the claims are patentably distinguishable from the prior art; (B) Amending the claims to patentably distinguish over the prior art; (C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR 41.203(a). See MPEP § 715 for information on the requirements of 37 CFR 1.131 affidavits. When the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not appropriate to overcome the rejection. (D) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10; (E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d) as explained in reference to 35 U.S.C. 102(e) above; (F) Perfecting benefit under 35 U.S.C. 119(e) or 120 as explained in reference to 35 U.S.C. 102(e) above."

The Examiner states that "if Applicants wish to demonstrate prior invention, an affidavit or declaration under 37 CFR §1.131 showing prior invention must be filed." *Office Action* at page 5.

Applicants continue to maintain that a patent application filed prior to the publication date of the cited reference is a permissible mechanism for establishing invention prior to the publication date of the reference. However, solely for the purpose of expediting the allowance of the present application, Applicants submit a Declaration Under 37 C.F.R. §1.131 herewith.

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As set forth in the accompanying Declaration, Applicants conceived of the polypeptide of SEQ ID NO: 68 and antibodies thereto prior to August 7, 2000. Furthermore, as evidenced by the Declaration and accompanying exhibits, Applicants exhibited diligence in reducing the subject matter of the claims to practice by performing various assays to confirm the function of the claimed polypeptides. Therefore, BE531149 et al. is not available as prior art under 35 U.S.C. § 102(a). Furthermore, in view of the elimination of BE531149 as prior art, the generic disclosure of methods of making antibodies in U.S. Patent No. 6,262,234 does not render the claimed antibodies obvious.

Conclusion


In view of the foregoing Applicants maintain that the application is in condition for allowance. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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